

PATENT
Application 09/843,289
Attorney Docket 2005P12928US (1120-005)

REMARKS

Applicant respectfully thanks the Examiner for the consideration provided to this application, and respectfully requests reconsideration of this application.

Each of claims 1-24 has been cancelled without prejudice or disclaimer.

Each of claims 26, 27, 35, 39, 46, and 52 has been amended for at least one reason unrelated to patentability, including at least one of: to explicitly present one or more elements, limitations, phrases, terms and/or words implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claims 25-100 are now pending in this application. Each of claims 25, 46, 58, 75, and 81 is in independent form.

I. The Obviousness Rejections

Each of claims 25-100 was rejected under 35 U.S.C. 103(a) as being obvious, and thus unpatentable, over various combinations of U.S. Patent 6,346,964 ("Rogers"), U.S. Patent 2006/0282544 ("Monteiro"), U.S. Patent 6,324,163 ("Alexanders"), U.S. Patent (IEEE-1996, Techniques for Improving the Capacity of Video on Demand ("Hari"), U.S. Patent 6,011,782 ("DeSimone"), and/or U.S. Patent 5,903,559 ("Acharya"). Each of these rejections is respectfully traversed.

A. Legal Standards

1. Overview of *Prima Facie* Criteria for an Obviousness Rejection

The Patent Act, namely, 35 U.S.C. 103, forbids issuance of a patent when "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art."

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Relatively recently, in *KSR International Co. v. Teleflex, Inc.*, 550 U.S. ___, 127 S. Ct. 1727, 2007 U.S. LEXIS 4745 (2007), the Supreme Court interpreted this law while highlighting the typical invention process. “**Inventions** usually rely upon building blocks long since uncovered, and claimed discoveries **almost necessarily will be combinations** of what, in some sense, is already known” (emphasis added). Yet, to properly apply §103, the Court recognized the need to filter, via obviousness analyses, true inventions from mere ordinary technological advances. “Granting patent protection to **advances that would occur in the ordinary course** without real innovation retards progress and may, in the case of patents combining previously known elements, deprive prior inventions of their value or utility” (emphasis added).

In *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court established factors regarding the factual inquiry required to establish obviousness. The factors include:

1. determining the scope and contents of the prior art;
2. ascertaining differences between the prior art and the claims at issue;
3. resolving the level of ordinary skill in the pertinent art; and
4. considering objective evidence indicating obviousness or nonobviousness.

Regarding proposed combinations of prior art, *KSR* clarified that the “[t]he question is not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the art”. Thus, in determining obviousness, both *KSR* and *Graham* warned against a “temptation to read into the prior art the teachings of the invention in issue” and instruct to “guard against slipping into the use of hindsight”.

KSR further warned, “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art”.

To heed these warnings, *KSR* explained the “import[ance]” of “identify[ing] a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does” (emphasis added). That is, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some **articulated reasoning** with some rational underpinning to support the legal conclusion of obviousness” (*quoting In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006) (emphasis added)). Thus, “[t]o facilitate review, this analysis should be made explicit”.

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Explaining the need for “a reason that would have prompted a person of ordinary skill”, *KSR* further taught that “if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill” (emphasis added). Further exploring this mandate, the Federal Circuit has recently recognized that “knowledge of a problem and motivation to solve it are entirely different from motivation to combine particular references”. *Innogenetics v. Abbott Laboratories* (Fed. Cir. 2007-1145) (8 January 2008).

Thus, according to the Supreme Court, a proper obviousness rejection must “identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does” and must present substantial evidence that one of ordinary skill **WOULD** recognize that alleged reason for making the particular claimed combination. It follows that if the alleged reason for making the particular combination of features is not evidenced to be art-recognized, then that reason **MUST BE** based on hindsight.

In addition to establishing a proper reason to combine, a proper obviousness rejection must clearly identify proposed reference(s) that:

1. are pertinent;
2. provide a reasonable expectation of success; and
3. teach... all the claim limitations

See MPEP 2143; MPEP 2143.03, *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); and additional citations *infra*.

Consistent with other patentability rejections, to establish a *prima facie* case of obviousness, substantial evidence must be provided that fulfills the mandates of the applicable law. The “Patent Office has the initial duty of supplying the factual basis for its rejection.” *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057, *reh'g denied*, 390 U.S. 1000 (1968). “It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis”. *Id.*

It is legal error to “substitute[] supposed *per se* rules for the particularized inquiry required by section 103. It necessarily produces erroneous results.” *See, In re Ochiai*, 71 F.3d

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1565, 1571, 37 USPQ2d 1127, 1132-33 (Fed. Cir. 1998); *In re Wright*, 343 F.2d 761, 769-770, 145 USPQ 182, 190 (CCPA 1965).

“Once the examiner... carries the burden of making out a *prima facie* case of unpatentability, ‘the burden of coming forward with evidence or argument shifts to the applicant.’” *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (*quoting In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444).

2. All Words in a Claim Must Be Considered

“To establish *prima facie* obviousness..., ‘[a]ll words in a claim must be considered’”. MPEP 2143.03, *quoting In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970); *see also, In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *In re Wilder*, 429 F.2d 447, 166 USPQ 545, 548 (CCPA 1970); *In re Angstadt*, 537 F.2d 498, 190 USPQ 214, 217 (CCPA 1976); *In re Geerdes*, 491 F.2d 1260, 180 USPQ 789, 791 (CCPA 1974).

3. Unfounded Assertions of Knowledge

Deficiencies of the cited references can not be remedied by general conclusions about what is basic knowledge or common sense to one of ordinary skill in the art. *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001). An assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* That is, such unfounded assertions are not permissible substitutes for evidence. *See, In re Lee*, 277 F.3d 1338, 1435, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002).

4. Determination of the Level of Skill

Consistent with *Graham*, “the level of ordinary skill in the art is a factual question that must be resolved and considered.” *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718, 21 USPQ2d 1053, 1057 (Fed. Cir. 1991). “The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.” *Id.* Thus, the “examiner must ascertain what would have been obvious to one of ordinary skill in the art at the time the invention was made, and ‘not to the inventor, a judge, a layman, those skilled in remote arts, or to geniuses in the art at hand’.” MPEP 2141.03, *quoting Environmental Designs, Ltd. v.*

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Union Oil Co., 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983), *cert. denied*, 464 U.S. 1043 (1984).

5. Pertinent Prior Art References

The *Graham* analysis requires that, to rely on a prior art reference as a basis for a rejection, the USPTO must show that the reference is “reasonably pertinent to the particular problem with which the invention was involved.” *Ruiz v. A.B. Chance Co.*, 234 F.3d 654, 664, 57 USPQ2d 1161, 1166 (Fed. Cir. 2000); *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1535, 218 USPQ 871, 876 (Fed. Cir. 1983); *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Oetiker*, 977 F.2d 1443, 1447 (Fed. Cir. 1992); *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006).

“References are selected as being reasonably pertinent to the problem based on the judgment of a person having ordinary skill in the art.” *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) (“[I]t is necessary to consider ‘the reality of the circumstances,’—in other words, common sense—in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor” (*quoting In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A. 1979))).

“If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his invention. If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.” *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) (*citing In re Clay*, 966 F.2d 656, 659-60 (Fed. Cir. 1992)).

Yet “[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness.” *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) (*quoting Ecolchem, Inc. v. S. Cal. Edison Co.*, 227 F.3d 1361, 1372 (Fed. Cir. 2000)).

6. Next Office Action

If an Office Action fails to set forth sufficient facts to provide a *prima facie* basis for the rejections, any future rejection based on the applied reference will necessarily be factually based

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on an entirely different portion of that reference, and thus will be legally defined as a “new grounds of rejection.” Consequently, any Office Action containing such rejection can not properly be made final. *See, In re Wiechert*, 152 USPQ 247, 251-52 (CCPA 1967) (defining “new ground of rejection” and requiring that “when a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference”), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967) (the USPTO “has the initial duty of supplying the factual basis for its rejection”).

B. Analysis

1. Claim 25

a. Inherency

Claim 25, from which each of claims 26-45 ultimately depends, states, *inter alia*, yet the applied portions of Rogers do not teach, “receiving from a subscriber unit a request for a list of available channels, **the request including information identifying a subscriber** and being sent using HTTP protocol”.

The present Office Action alleges, at Page 3, that this claimed subject matter is taught by Rogers at “fig. 7a, step 701”. Yet, FIG. 7A, step 701 of Rogers merely states, “send call request to switch”. The present Office Action admits that this applied portion of Rogers does not teach “the request including information identifying a subscriber”, yet asserts (emphasis added), “the identity of the subscriber is **inherent** in the request so that the server could be able to send back a list of available program”. No evidence has been presented that the admittedly “missing descriptive material is ‘necessarily present’” in Rogers. Applicant respectfully requests provision of evidence supporting the assertion that the missing claimed subject matter of “the request including information identifying a subscriber” is necessarily present in the applied portions of Rogers and not merely probably or possibly present.

To the extent that the present Office Action or any future Office Action intends to rely on inherency to support a claim rejection, Applicant respectfully traverses, respectfully requests provision of proper evidence supporting such rejection, and respectfully requests a detailed

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explanation of how the “missing descriptive material is necessarily present, not merely probably or possibly present”, in any prior art reference cited to support such rejection.

b. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

c. Missing Claim Limitations

On 5 November 2007, a Declaration of Dr. Jun Shan Wey was entered into the record. Dr. Wey is an employee of Nokia Siemens Networks, the assignee of the present application. In the Declaration, Dr. Wey testified from the perspective of one of ordinary skill in the art regarding the present application as of its effective filing date, 24 April 2001. According to paragraphs 21-27 of Dr. Wey’s Declaration, one of ordinary skill in the art would find that claim 25, from which each of claims 26-45 ultimately depends, states, *inter alia*, yet the applied portions of Rogers do not teach or enable, “sending to the subscriber unit a response to the received request with an indication of the identified channels, the response being sent using HTTP protocol and identifying the IP multicast group assigned to each identified channel”.

No evidence is of record that the applied portions of Monteiro overcome the deficiencies of Rogers.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), one of ordinary skill in the art would find that no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of the independent claims, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

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d. Lack of Required Factual Evidence of Obviousness

Applicant respectfully notes that the present Office Action fails to evidence the scope and contents of the prior art as required under *Graham*. The present Office Action fails to even identify what "the pertinent art" is. Moreover, the present Office Action fails to evidence the level of ordinary skill in the pertinent art.

Applicant respectfully traverses the failure of the present Office Action to comply with the requirements of *Graham* and thereby, to provide a *prima facie* rejection under 35 U.S.C. 103.

e. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Rogers and Monteiro, that are used in rejecting claim 25, in such a manner so as to arrive at the claimed subject matter of claim 25. Regarding the proffered combination of the applied portions of Rogers and Monteiro, the present Office Action states, at Pages 3-4, "it would have been obvious to an artisan to apply Monteiro's teaching to Roger's system with the motivation being to control which user to receive the real time information."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 25 cannot be sustained based upon the mere conclusory statements of the present Office Action.

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f. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 25 is respectfully requested. Reconsideration of each of claims 26-45, each of which ultimately depends from claim 25 is also respectfully requested.

2. Claim 26

The rejection of claim 26 is traversed as moot in view of the present amendments to claim 26. Specifically, claim 26 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "the request to join the IP multicast group being an Internet Group Management Protocol (IGMP) request".

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 26 is respectfully requested.

3. Claim 27

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

Claim 27 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Rogers teach, "wherein the identifying of one or more available channels identifies less than all of the available channels". The present Office Action alleges this claimed subject matter is taught by Rogers at "fig. 7a, step 703. Yet, Rogers allegedly illustrates, at Fig. 7a, step 703, "USER SELECTS A PROGRAM (SEND TO SWITCH)". No evidence is presented that a "user" that "selects a program" that is sent "to switch" teaches, "wherein the identifying of one or more available channels identifies less than all of the available channels"

No evidence is presented that applied portions of Monteiro cure at least these deficiencies of the applied portions of Rogers.

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Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of claim 27, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combination of Rogers and Monteiro no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 27 in such a manner so as to arrive at the claimed subject matter of claim 27.

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be based on hindsight**. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness.

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 27 is respectfully requested.

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4. Claim 28

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of the applied portions of the relied-upon references, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of Rogers, Monteiro and Hari, that are used in rejecting claim 28, in such a manner so as to arrive at the claimed subject matter of claim 28. Regarding the proffered combination of the applied portions of Rogers, Monteiro and Hari, the present Office Action states, at Page 8, "it would have been obvious to an artisan to apply Hari's teaching Rogers's system with the motivation being to provide one user requesting a video."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized **reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be based on hindsight**. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 28 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 28 is respectfully requested.

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5. Claim 29**a. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

Claim 29 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Rogers teach, "wherein available channels are provided to the computer system by receiving from a plurality of content providers indications of **channels** that are made available by each content provider". The present Office Action alleges, at Page 4, that Rogers teaches this claimed subject matter at "fig. 7a, step 702". Yet, Rogers illustrates, at Fig. 7a, step 702, "SWITCH SENDS LIST OF AVAIL. **PROGRAMS**". Yet, this applied portion of Rogers is silent regarding a "content provider". Accordingly, no evidence is of record that Rogers teaches, "wherein available channels are provided to the computer system by receiving from a plurality of content providers indications of channels that are made available by each content provider".

No evidence is of record that the applied portions of Monteiro cure at least these deficiencies of the applied portions of Rogers.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of claim 29, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combination of Rogers and Monteiro, no evidence or

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reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 29 in such a manner so as to arrive at the claimed subject matter of claim 29.

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized **reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness.

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 29 is respectfully requested.

6. Claim 30

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

Claim 30 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Hari teach, “wherein an indication that a channel is made available by a content provider is sent using a session announcement protocol”. Yet, the applied portion of Hari does not even mention a “session announcement protocol”.

No evidence is presented that the applied portions of the remaining relied-upon references cure at least these deficiencies of the applied portions of Hari.

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Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of claim 30, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro, Rogers, and Hari, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 30, in such a manner so as to arrive at the claimed subject matter of claim 30. Regarding the proffered combination of Monteiro, Rogers, and Hari the present Office Action states, at Page 9, "it would have been obvious to an artisan to apply Hari's teaching to Rogers's system with the motivation being to provide a user the flexibility of selecting the content as well as scheduling the program that the user wants to watch without disturbed."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized **reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion

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of obviousness. The rejection of claim 30 cannot be sustained based upon the mere conclusory statements of the present Office Action.

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 30 is respectfully requested.

7. Claim 31

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro, Rogers, and Hari, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 31, in such a manner so as to arrive at the claimed subject matter of claim 31. Regarding the proffered combination of Monteiro, Rogers, and Hari the present Office Action states, at Page 10, "it would have been obvious to an artisan to apply Hari's teaching to Rogers's system with the motivation being to provide a user the flexibility of selecting the content as well as scheduling the program that the user wants to watch without disturbed."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized **reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion

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of obviousness. The rejection of claim 31 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 31 is respectfully requested.

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8. Claim 32

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of Monteiro, Rogers, and DeSimone, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 32, in such a manner so as to arrive at the claimed subject matter of claim 32. Regarding the proffered combination of Monteiro, Rogers, and DeSimone the present Office Action states, at Page 12, "it would have been obvious to an artisan to apply DeSimone's teaching to Rogers's system with the motivation being to provide real time interactive distribution of multimedia information using the multicast IP service."

The present Office Action provides no evidence that the claimed subject matter would have occurred in the ordinary course without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason must be based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 32 cannot be sustained based upon the mere conclusory statements of the present Office Action.

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For at least these reasons, a reconsideration and withdrawal of the rejection of claim 32 is respectfully requested.

9. Claim 33

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro, Rogers, and Alexanders, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 33, in such a manner so as to arrive at the claimed subject matter of claim 33. Regarding the proffered combination of Monteiro, Rogers, and Alexanders the present Office Action states, at Page 7, "it would have been obvious to provide data over ATM network unicastly."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 33 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 33 is respectfully requested.

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10. Claim 34**a. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Inherency

Claim 34 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon reference teaches, “wherein the channel source address is an ATM virtual path and transmission circuit”.

The present Office Action asserts, at Page 7 (emphasis added):

Alexander (6,324,163) discloses wherein the channel source address is an ATM virtual path and transmission circuit (col.2, lines 40-44 wherein the VCC is ATM virtual path and the transmission circuit is **inherent** in the transmit functionality as when the data being transmitted to a destination—emphasis added).

No evidence has been presented that the admittedly “missing descriptive material is ‘necessarily present’” in Alexander. Applicant respectfully requests provision of evidence supporting the assertion that the admittedly missing claimed subject matter of “wherein the channel source address is an ATM virtual path and transmission circuit” is necessarily present in the applied portions of Alexander.

To the extent that the present Office Action or any future Office Action intends to rely on inherency to support a claim rejection, Applicant respectfully traverses, respectfully requests provision of proper evidence supporting such rejection, and respectfully requests a detailed explanation of how the “missing descriptive material is necessarily present, not merely probably or possibly present”, in any prior art reference cited to support such rejection.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro, Rogers, and Alexanders, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 34, in

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such a manner so as to arrive at the claimed subject matter of claim 34. Regarding the proffered combination of Monteiro, Rogers, and Alexanders the present Office Action states, at Page 7, "it would have been obvious to apply Alexander's teaching to Rogers's system with the motivation being to provide data over ATM network unicastly."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized **reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 34 cannot be sustained based upon the mere conclusory statements of the present Office Action.

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 34 is respectfully requested.

11. Claim 35

The rejection of claim 35 is traversed as moot in view of the present amendments to claim 35. Specifically, claim 35 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, "the subscriber unit adapted to leave the IP multicast group via a sent Internet Group Management Protocol (IGMP) request to leave the multicast group".

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 35 is respectfully requested.

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12. Claim 36

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Rogers and Monteiro no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 36 in such a manner so as to arrive at the claimed subject matter of claim 36.

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized **reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 36 is respectfully requested.

13. Claim 37

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro and Rogers, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 37, in such a manner so as to arrive at the claimed subject matter of claim 37. Regarding the proffered combination of Monteiro and Rogers the present Office Action states, at Page 10, "it would have

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been obvious to an artisan to apply Hari's teaching to Rogers's system with the motivation being to improve the capacity of video on demand system."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 37 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 37 is respectfully requested.

14. Claim 38

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Rogers and Monteiro no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 38 in such a manner so as to arrive at the claimed subject matter of claim 38.

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Because

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the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 38 is respectfully requested.

15. Claim 39

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

By rejecting claims 32, 39-40, 52-53, 64, and 94-95 as a group, the Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d) (a “plurality of claims should **never** be grouped together in a common rejection, unless the rejection is **equally applicable** to all claims in the group.”).

For example, unlike the other claims in the rejected group, claim 39 states “wherein the subscriber is identified using a media access control address”. The common rejection of claims 32, 39-40, 52-53, 64, and 94-95 as a group makes no mention of “wherein the subscriber is identified using a media access control address”, and fails to point out where, in any of the references, that claimed subject matter is disclosed. In view of the failure of the Office Action to fully satisfy the requirements of MPEP 707.07(d), the next Office Action should not be final.

In addition, the rejection of claim 39 is traversed as moot in view of the present amendments to claim 39. Specifically, claim 39 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of the relied-upon references teach, “the media access control address obtained from an Internet Protocol address via an Address Resolution Protocol”.

Thus, even if there were proper evidence of obviousness presented in the Office Action

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(an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of claim 39, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro, Rogers, and DeSimone, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 39, in such a manner so as to arrive at the claimed subject matter of claim 39. Regarding the proffered combination of Monteiro, Rogers, and DeSimone the present Office Action states, at Page 12, "it would have been obvious to an artisan to apply DeSimone's teaching to Rogers's system with the motivation being to provide real time interactive distribution of multimedia information using the multicast IP service."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized **reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion

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of obviousness. The rejection of claim 39 cannot be sustained based upon the mere conclusory statements of the present Office Action.

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d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 39 is respectfully requested.

16. Claim 40

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

By rejecting claims 32, 39-40, 52-53, 64, and 94-95 as a group, the Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d) (a "plurality of claims should **never** be grouped together in a common rejection, unless the rejection is **equally applicable** to all claims in the group.").

For example, unlike the other claims in the rejected group, claim 40 states "wherein the subscriber is identified using an IP address". The common rejection of claims 32, 39-40, 52-53, 64, and 94-95 as a group makes no mention of "wherein the subscriber is identified using an IP address", and fails to point out where, in any of the references, that claimed subject matter is disclosed. In view of the failure of the Office Action to fully satisfy the requirements of MPEP 707.07(d), the next Office Action should not be final.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of

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claim 40, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro, Rogers, and DeSimone, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 40, in such a manner so as to arrive at the claimed subject matter of claim 40. Regarding the proffered combination of Monteiro, Rogers, and DeSimone the present Office Action states, at Page 12, "it would have been obvious to an artisan to apply DeSimone's teaching to Rogers's system with the motivation being to provide real time interactive distribution of multimedia information using the multicast IP service."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason **that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be based on hindsight**. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 40 cannot be sustained based upon the mere conclusory statements of the present Office Action.

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 40 is respectfully requested.

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17. Claim 41**a. *Prima Facie* Criteria**

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

Claim 41 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Rogers teach, “providing a subscribed channel list for the subscriber that indicates channels which the subscriber is permitted to access”. The present Office Action alleges that this claimed subject matter is taught by Rogers at “fig. 7a, step 702. Yet, Rogers illustrates, at Fig. 7a, step 702, “SWITCH SENDS LIST OF AVAIL. PROGRAMS” (emphasis added). No evidence is presented that one having ordinary skill in the art would find that a “list” of “programs” teaches a “channel list”. Moreover, the applied portion of Rogers is silent regarding any “subscribed” “list” whatsoever.

No evidence is presented that the applied portions of Monteiro cure at least these deficiencies of the applied portions of Rogers.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, as **attempted to be modified and/or combined**, expressly or inherently teach every limitation of claim 41, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combination of Rogers and Monteiro no evidence or

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reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 41 in such a manner so as to arrive at the claimed subject matter of claim 41.

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized **reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness.

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 41 is respectfully requested.

18. Claim 42

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

Claim 42 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Rogers teach, “wherein data for a channel is received at the computer system and forwarded to the subscriber unit”. The present Office Action alleges that this claimed subject matter is taught by Rogers at “fig. 7a, step 702. Yet, Rogers allegedly illustrates, at Fig. 7a, step 702, “SWITCH SENDS LIST OF AVAIL. PROGRAMS” (emphasis added). No evidence is

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presented that one having ordinary skill in the art would have found that a "list" of "programs" teaches a "channel".

No evidence is presented that the applied portions of Monteiro cure at least these deficiencies of the applied portions of Rogers.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, **as attempted to be modified and/or combined**, expressly or inherently teach every limitation of claim 42, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Rogers and Monteiro no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 42 in such a manner so as to arrive at the claimed subject matter of claim 42.

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness.

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d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 42 is respectfully requested.

19. Claim 43

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of Monteiro, Rogers, and Acharya, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 43, in such a manner so as to arrive at the claimed subject matter of claim 43. Regarding the proffered combination of Monteiro, Rogers, and Acharya the present Office Action states, at Page 14:

it would have been obvious to an artisan to apply Acharya's teaching to Rogers's system with the motivation being to provide transmits data as a series of variable length packets, each having a circuit number that identifies its source and destination address."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized **reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 43 cannot be sustained based upon the mere conclusory statements of the present Office Action.

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For at least these reasons, a reconsideration and withdrawal of the rejection of claim 43 is respectfully requested.

20. Claim 44

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro, Rogers, and DeSimone, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 44, in such a manner so as to arrive at the claimed subject matter of claim 44. Regarding the proffered combination of Monteiro, Rogers, and DeSimone the present Office Action states, at Page 13, "it would have been obvious to an artisan to apply DeSimone's teaching to Rogers's system with the motivation being to provide packets only to the requested client over the multicast IP network." The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized **reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 44 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 44 is respectfully requested.

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21. Claim 45

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Rogers and Monteiro no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 45 in such a manner so as to arrive at the claimed subject matter of claim 45.

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized **reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 45 is respectfully requested.

22. Claim 46**a. Inherency**

Claim 46, from which each of claims 47-57 ultimately depends, states, *inter alia*, yet the applied portions of Rogers do not teach, “receiving from a subscriber unit a request for a list of available channels, **the request including information identifying a subscriber** and being sent using HTTP protocol”.

The present Office Action alleges, at Page 3, that this claimed subject matter is taught by Rogers at “fig. 7a, step 701”. Yet, FIG. 7A, step 701 of Rogers merely states, “send call request to switch”. The present Office Action admits that this applied portion of Rogers does not teach

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“the request including information identifying a subscriber”, yet asserts (emphasis added), “the identity of the subscriber is **inherent** in the request so that the server could be able to send back a list of available program”. No evidence has been presented that the admittedly “missing descriptive material is ‘necessarily present’” in Rogers. Applicant respectfully requests provision of evidence supporting the assertion that the missing claimed subject matter of “the request including information identifying a subscriber” is necessarily present in the applied portions of Rogers.

To the extent that the present Office Action or any future Office Action intends to rely on inherency to support a claim rejection, Applicant respectfully traverses, respectfully requests provision of proper evidence supporting such rejection, and respectfully requests a detailed explanation of how the “missing descriptive material is necessarily present, not merely probably or possibly present”, in any prior art reference cited to support such rejection.

b. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

c. Missing Claim Limitations

By rejecting claims 25, 46, 58, 75, and 81 as a group, the Office Action appears to improperly group claims together in a common rejection without any showing that the rejection is equally applicable to all claims in the group. That is never appropriate. *See* MPEP 707.07(d) (a “plurality of claims should **never** be grouped together in a common rejection, unless the rejection is **equally applicable** to all claims in the group.”).

For example, unlike the other claims in the rejected group, claim 46 states “the response managed via IP multicast capable TCP/IP software”. The common rejection of claims 25, 46, 58, 75, and 81 as a group makes no mention of “the response managed via IP multicast capable TCP/IP software”, and fails to point out where, in any of the references, that claimed subject matter is disclosed. In view of the failure of the Office Action to fully satisfy the requirements of MPEP 707.07(d), the next Office Action should not be final.

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According to paragraphs 21-27 of Dr. Wey's Declaration, one of ordinary skill in the art would find that claim 46, from which each of claims 47-57 ultimately depends, states, *inter alia*, yet the applied portions of Rogers do not teach or enable, "sending to the subscriber unit a response to the received request with an indication of the identified channels, the response being sent using HTTP protocol and **identifying the IP multicast group assigned to each identified channel**".

No evidence is of record that the applied portions of Monteiro overcome the deficiencies of Rogers.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, as **attempted to be modified and/or combined**, expressly or inherently teach every limitation of the independent claims, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

d. Lack of Required Factual Evidence of Obviousness

The present Office Action fails to evidence the scope and contents of the prior art as required under *Graham*. The present Office Action fails to even identify what "the pertinent art" is. Moreover, the present Office Action fails to evidence the level of ordinary skill in the pertinent art.

Applicant respectfully traverses the failure of the present Office Action to comply with the requirements of *Graham* and thereby, to provide a *prima facie* rejection under 35 U.S.C. 103.

e. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combinations of Monteiro and Rogers, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied

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portions of the relied-upon references, that are used in rejecting claim 46, in such a manner so as to arrive at the claimed subject matter of claim 46. Regarding the proffered combination of Monteiro and Rogers the present Office Action states, at Pages 3 and 4 "it would have been obvious to an artisan to apply Monteiro's teaching to Roger's system with the motivation being to control which user to receive the real time information."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized **reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness. The rejection of claim 46 cannot be sustained based upon the mere conclusory statements of the present Office Action.

f. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 46 is respectfully requested. Reconsideration of each of claims 47-57, each of which ultimately depends from claim 46 is also respectfully requested.

23. Claim 47

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

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b. Missing Claim Limitations

Claim 47 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Rogers teach, "wherein the identifying of one or more available channels identifies less than all of the available channels". The present Office Action alleges that this claimed subject matter is taught by Rogers at "fig. 7a, step 703". Yet, Rogers illustrates, at Fig. 7a, step 703, "USER SELECTS A PROGRAM (SEND TO SWITCH)". No evidence is of record that a "user" that "selects a program" that is sent "to switch" teaches, "wherein the identifying of one or more available channels identifies less than all of the available channels"

No evidence is of record that the applied portions of Monteiro overcome the deficiencies of Rogers.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, as **attempted to be modified and/or combined**, expressly or inherently teach every limitation of claim 47, and consequently the Office Action fails to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Rogers and Monteiro no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 47 in such a manner so as to arrive at the claimed subject matter of claim 47.

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that would have prompted a person of ordinary skill in the

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relevant field to combine the elements **in the way the claimed new invention does**. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness.

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 47 is respectfully requested.

24. Claim 48

The present Office Action fails to provide evidence of obviousness as required under KSR. For example, regarding the proffered combinations of Monteiro, Rogers, and Hari, no evidence is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references, that are used in rejecting claim 48, in such a manner so as to arrive at the claimed subject matter of claim 48. Regarding the proffered combination of Monteiro, Rogers, and Hari the present Office Action states, at Page 8, "it would have been obvious to an artisan to apply Hari's teaching Rogers's system with the motivation being to provide one user requesting a video."

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized reason that **would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Instead, the present Office Action merely provides impermissible conclusory statements. Because the present Office Action fails to present substantial evidence that one of ordinary skill **would** recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion

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of obviousness. The rejection of claim 48 cannot be sustained based upon the mere conclusory statements of the present Office Action.

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 48 is respectfully requested.

25. Claim 49

a. *Prima Facie* Criteria

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

b. Missing Claim Limitations

Claim 49 states, *inter alia*, yet no substantial evidence has been presented that the applied portions of Rogers teach, "wherein available channels are provided to the computer system by receiving from a plurality of content providers **indications of channels that are made available by each content provider**". The present Office Action alleges that this claimed subject matter is taught by Rogers at "fig. 7a, step 702". Yet, Rogers illustrates, at Fig. 7a, step 702, "SWITCH SENDS LIST OF AVAIL. PROGRAMS". This applied portion of Rogers is silent regarding any "content provider" whatsoever. Accordingly, no evidence is of record that Rogers teaches, "wherein available channels are provided to the computer system by receiving from a plurality of content providers **indications of channels that are made available by each content provider**".

No evidence is of record that the applied portions of Monteiro overcome the deficiencies of Rogers.

Thus, even if there were proper evidence of obviousness presented in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), no substantial evidence has been presented the applied portions of the references relied upon in the Office Action, as **attempted to be modified and/or combined**, expressly or inherently teach every limitation of claim 49, and consequently the Office Action fails to establish a *prima facie* case of obviousness.

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Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

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c. Lack of Evidence of a Reason to Combine References

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Rogers and Monteiro no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would combine the applied portions of the relied-upon references are used in rejecting claim 49 in such a manner so as to arrive at the claimed subject matter of claim 49.

The present Office Action provides no evidence that the claimed subject matter **would have occurred in the ordinary course** without real innovation or that the combination would have been obvious to a person with ordinary skill in the art. The present Office Action fails to evidence an art-recognized **reason that would have prompted** a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does**. Because the present Office Action fails to present substantial evidence that one of ordinary skill would recognize that alleged reason for making the particular claimed combination and does not evidence the reason to be art-recognized, the stated reason **must be** based on hindsight. Thus, the present Office Action fails to provide a rational underpinning to support the legal conclusion of obviousness.

d. Conclusion

For at least these reasons, a reconsideration and withdrawal of the rejection of claim 49 is respectfully requested.

26. Claim 50

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establishes a *prima facie* case of obviousness.

The present Office Action fails to provide evidence of obviousness as required under *KSR*. For example, regarding the proffered combination of Rogers and Monteiro no evidence or reasoning is provided whatsoever regarding why one having ordinary skill in the art would